UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/876,563	06/07/2001	Marc F. Hayes JR.	12587-007001	7804

26212 7590 11/18/2003		EXAMINER
FISH & RICHARDSON P.C.		RHODE JR, ROBERT E
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NEW YORK, NY 10111	ART UNIT	PAPER NUMBER
	3625	

DATE MAILED: 11/18/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.		Applicant(s)
Office Action Summary	09/876,563		HAYES ET AL.
	Examiner		Art Unit
	Rob Rhode		3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>30 May 2003</u> .

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-50</u> is/are pending in the application.

4a) Of the above claim(s) <u>51-63</u> is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-50</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .

4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: .

DETAILED ACTION

Response to Amendment

The office action of 1/30/2003 rejected claims 1 – 5, 7 – 11, 13 – 16, 21 – 29, 34 – 43 and 45 – 49 as anticipated by Oracle. Remaining claims 6, 12, 17 – 20, 30 – 33, 44 and 50 were rejected as unpatentable over Oracle in view of Convergys.

Applicant amendment of 5/30/2003 amended claims 1, 4, 7, 10, 13 – 14, 23, 26, 39 – 41 and 45 – 48 and withdrew claims 51 - 63 as well as traversed rejections of Claims 1 - 50.

Currently, claims 1- 50 are pending.

Claim Rejections - 35 USC § 112

The applicant's amendment fully addressed the 35 USC 112 rejections for claims 4, 10, 13, 23, 26, 41, 46 and 47 as well as overcoming with persuasive arguments the rejections of claims 13 and 26.

Claim Rejections - 35 USC § 101

The applicant's amendment did not overcome the 35 USC 101 rejections of claims 1, 13 and 39.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1 - 6, 13 - 25 and 39 - 44 are rejected under 35 U.S.C. 101. In these claims, the claimed invention is directed to non-statutory subject matter. The claims are directed to a process that does nothing more than manipulate an abstract idea. There is no practical application in the technological arts. See In re Musgrave, 167 USPQ 280 (CCPA 1970) and In re Johnston, 183 USPQ 172 (CCPA 1974). For example in claim 1, the invention in the body of the claim does not recite the use of nor incorporate any technology in carrying out the recited method steps and therefore is not statutory. If the invention in the body of the claim is not tied to the technological arts, environment or machine, the claim is not statutory. See Ex parte Bowman, 61 USPQ2d 1665, 1671 (BD. Pat. App. & Inter. 2001) [Unpublished] and note MPEP 2106 IV 2(b). While Bowman is not precedential, it has been cited for its analysis.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1 – 5, 7 – 11, 13 – 16, 21 – 29, 34 – 43 and 45 – 49 are rejected under

35 U.S.C. 103(a) as being unpatentable over "Oraclemobile.com spin-off to focus

on wireless"; CENT News.com; February 22, 2000; Stephanie Miles (hereafter

referred to as Oracle) in view of Lefeber (US 2002/0046299).

Regarding Claim 1 and related Claims 7, 13, 26, 39 and 45, the combination of Oracle

and Lefeber teaches a computerized method comprising – where Oracle is providing a

customer messaging and alert service (CMAS) for use by customers (see at least Page

1, Para 4); permitting a customer to enroll in the CMAS and to authorize at least one

business, selected from a group of affiliated businesses, to contact the customer (see at

least Page 4, Para 1). Regarding Claim 2 and related Claims 8, 21, 34, 43 and 49,

Oracle teaches a method wherein a customer enrolls by providing information to at least

one of a participating business website, a customer messaging and alert service

website, and to a customer services representative (Page 4, Para 1). In addition and

regarding Claim 24 and related Claim 37, Oracle teaches a method further comprising

generating reports for use by the affiliated businesses (Page 2, Para 8) and wherein the

reports include at least one of completed transaction summaries (Page 2, Para 8), peak

number of transactions by channel, transaction failure by channel, transaction frequency

by channel, and customer intent and regarding Claim 25 and relate Claim 38, Oracle

teaches a method wherein the reports include at least one of completed transaction

summaries, peak number of transactions by channel, transaction frequency by channel,

and customer intent (Page 2, Para 8).

However and though it is implicit, Oracle does not specifically disclose and teach permitting the customer to specify a contact hierarchy list of communication types including ranked customer contact information; monitoring the chosen businesses with a CMAS engine; and alerting the customer when an authorized business has a message by attempting to contact the customer according to that customer's hierarchy list of ranked customer contact information.

On the other hand, Lefeber does disclose and teach permitting the customer to specify a contact hierarchy list of communication types including ranked customer contact information (see at least Abstract, Page 4, Para 0032 & 0035 and Page 7, Para 0056); monitoring the chosen businesses with a CMAS engine (see at least Abstract and Page 6 & 7, Para 0054 and Figure 2); and alerting the customer when an authorized business has a message by attempting to contact the customer according to that customer's hierarchy list of ranked customer contact information (see at least Page 1, Para 002 and Page 4, Para 0032 & 0033). Moreover:

regarding Claim 3 and related Claims 9, 22, 27, 35, 42 and 48, Lefeber teaches a method wherein the customer contact hierarchy list includes at least one of telephone information, instant messaging information, e-mail information, pager information and wireless device information (Figures 1 and 2).

regarding Claim 4 and related Claims 10, 23 and 36, Lefeber teaches a method further

comprising storing a list of customer preferences that include at least one of selected

businesses to contact, selected businesses authorized to send alert messages, when

the customer may he contacted and messages that require confirmation (Abstract and

Page 6, Para 0049).

regarding Claim 5 and related Claim 11, Lefeber teaches a method further comprising

permitting the customer to contact any of the selected businesses (Page 6, Para 0053).

regarding claim 14, Lefeber teaches a method, wherein the ranked customer contact

information include at least one of instant messaging, e-mail, telephone service, short-

messaging system messages, wireless calls and voice messaging (Page 5, Para 0039).

regarding Claim 15 and related Claim 28, Lefeber teaches a method, further comprising

contacting a business that sent an alert when the customer acknowledges receipt of the

alert (Abstract).

regarding Claim 16 and related Claim 29; Lefeber teaches method further comprising

permitting the customer to contact any of the affiliated businesses (Abstract).

regarding Claim 40 and related Claim 46, Lefeber teaches a method of enrolling

includes at least one of selecting those businesses that are authorized for responding,

to queries, selecting those businesses authorized to send alert messages, generating

the contact hierarchy list, and specifying preferences (see at least Abstract and Page 3,

Para 0016, 0017) and wherein the list of preferences includes at least one of when

communications can be initiated, and the messages that require confirmation (Page 4,

Para 0031, 0032 and 0035).

regarding Claim 41 and related Claim 47, Lefeber teaches a method wherein the list of

preferences includes at least one of when communications can be initiated, and the

messages that are require confirmation (Page 4, Para 1 and 4).

It would have been obvious to one of ordinary skill in the art at the time of the invention

to have provided the method and article of Oracle with the method and article of Lefeber

to have enabled a computerized method comprising – where Oracle is providing a

customer messaging and alert service (CMAS) for use by customers; permitting a

customer to enroll in the CMAS and to authorize at least one business, selected from a

group of affiliated businesses, to contact the customer; permitting the customer to

specify a contact hierarchy list of communication types including ranked customer

contact information; monitoring the chosen businesses with a CMAS engine; and

alerting the customer when an authorized business has a message by attempting to

contact the customer according to that customer's hierarchy list of ranked customer

contact information – in order to provide a full service method and article for wireless

messaging and alerting. In this regard, the customer's satisfaction will be enhanced as a

result of it's features such as near real time alert(s) via any device, which will ensure

that they will continue to use the system for critical alerts – as well as recommend the

service to others.

Claims 6, 12, 17 – 20, 30 – 33, 44 and 50 are rejected under 35 U.S.C. 103(a)

as being unpatentable over the combination of Oracle and Lefeber as applied to

claims 1, 7, 13, 26 39 and 45 above, and further in view of "Convergys to market

Neuromedia's web sales and support software"; Telecomworld; Coventry; April

18, 2000 (hereafter referred to as Convergys).

The combination of Oracle and Lefeber substantially disclose and teach the applicant's

invention.

On the other hand, the combination of Oracle and Lefeber does not specifically disclose

and teach a method and article wherein the customer submits a natural language query

that is interpreted by the messaging and alert service.

However regarding Claim 6 and related Claims 12, 17, 30, 44 and 50, Convergys

teaches a method and article wherein the customer submits a natural language query

that is interpreted by the messaging and alert service (Page 1, Para 2 and 3)

Regarding Claims 18 and related Claim 31, the recitation that "wherein CMAS utilizes

at least one dataset of customer intent data to interpret the natural language query",

such recitation is given little patentable weight because it imparts no structural or

functional specificity which serves to patentably distinguish the instant invention from

the other recitation "wherein the customer submits a natural language query that is

interpreted by the messaging and alert service" already disclosed by Convergys.

Regarding Claims 19 and related Claim 32, the recitation that " wherein the customer

intent data is enterprise specific", such recitation is given little patentable weight

because it imparts no structural or functional specificity which serves to patentably

distinguish the instant invention from the other recitation "wherein the customer submits

a natural language query that is interpreted by the messaging and alert service" already

disclosed by Convergys.

Regarding Claims 20 and related Claim 33, the recitation that "tracking the natural

language queries", such recitation is given little patentable weight because it imparts no

structural or functional specificity which serves to patentably distinguish the instant

invention from the other recitation "wherein the customer submits a natural language

query that is interpreted by the messaging and alert service" already disclosed by

Convergys.

It would have been obvious to one of ordinary skill in the art at the time of the invention

to have provided the method and article of Oracle with the method and article of

Convergys to have provided the capability to enable the customer to submit a natural

language query that is interpreted by a messaging and alert service – in order to provide

a more intuitive, ease to use customer interface which can increase usage of the

service and thereby increase revenue from additional transactions.

Response to Arguments

Applicant's arguments with respect to claims 1 - 50 have been considered but are

moot in view of the new ground(s) of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in

this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37

CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any

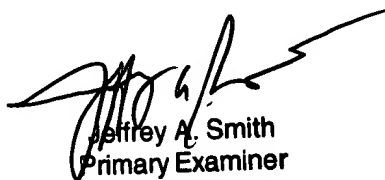extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rob Rhode whose telephone number is 703.305.8230. The examiner can normally be reached on M-F 7:30am - 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeff Smith can be reached on 703.308.3588. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703.306.1113.

RER

Jeffrey A. Smith
Primary Examiner